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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Philip J. Passantino

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EXAMINER

RAPILLO, KRISTINE K

ART UNIT

PAPER NUMBER

3626

NOTIFICATION DATE

DELIVERY MODE

05/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/035,970	<b>Applicant(s)</b> PASSANTINO, PHILIP J.	
	<b>Examiner</b> KRISTINE K. RAPILLO	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/12/2002</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

Claims 13– 21 are pending.

#### ***Notice to Applicant***

1. This communication is in response to the amendment filed 3/15/2008. No claims were amended.

Claims 13 - 21 are presented for examination.

#### ***Claim Objections***

2. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant has acted as his own lexicographer and re-defined client to include all limitations of claim 14. Applicant defined client (paragraph [0023] of the specification) as payors and employers, where payors can be HMO's, POS plans, PPO's, TPA's, large, self-insured employers, and traditional indemnity insurance carriers. Therefore claim 14 is equal in scope to claim 13. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg, (U.S. Pub. 2002/0065682), in view of Joao, (U.S. 2002/0032099).**

As per claims 13 and 14, Goldenberg discloses a computer-based method of managing a network of physicians comprising the steps of:

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- Providing secure access to the network to a client through a computer terminal, (Goldenberg, Figure 3 and paragraphs [0009], [0042], [0047]) (passwords providing secure and limited access);
- allowing said client to request a referral for a specific medical need, (Goldenberg, paragraphs [0015], [0050-53], and [0067]);
- retrieving from a referral database information about at least one physician capable of handling the referral, (Goldenberg, paragraphs [0015], [0050-53], and [0067]);
- displaying said information for said client, (Goldenberg, paragraphs [0015], [0050-53], and [0067]);
- allowing said client to select said at least one physician, (Goldenberg, paragraphs [0015], [0050-53], and [0067]);
- requesting a response from said client to at least one inquiry established by said at least one physician, (Goldenberg, paragraphs [0050] and [0067])(disclosing questions from physician to patient regarding past diagnosis and treatment, said questions being a form of inquiry);
- securely transmitting patient information from a client database to said at least one physician after receiving a response to said inquiry, (Goldenberg, paragraph [0040]) (disclosing an information retrieval system that encodes data for security purposes);
- generating a request to have said at least one physician provide medical services, (Goldenberg, paragraphs [0015], [0050-53], and [0067]); and
- tracking said request to ensure that the medical services are provided, (Goldenberg, paragraph [0050])(disclosing a system programmed to select another physician to perform the medical services if the first physician cannot perform the requested medical service, thus ensuring that the requested medical services are provided).

Goldenberg fails to disclose a method wherein said client is selected from the group consisting of an HMO, a PPO, a POS plans, a TPA, a self-insured employer, a health insurance carrier, and a payor. However, such a method step is well-known in the art as evidenced by Joao, (Joao, paragraph [0251])(disclosing a user as a payor).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Goldenberg and Joao. The motivation would have been to process healthcare claims, (Joao, paragraph [0043]).

As per claim 15, Goldenberg discloses a method further comprising the step of confirming that said client is authorized to access said network of physicians, (Goldenberg, paragraphs 42, 47) (the password and user I.D. are used to confirm access authorization).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

As per claim 16, Goldenberg discloses a method wherein said physician database comprises a plurality of physician profiles, (Goldenberg, paragraph 50) (selected professional resumes are displayed, said resume are considered to be a profile).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

As per claim 17, Goldenberg discloses a method wherein each of said plurality of physician profiles includes said at least one inquiry, (Goldenberg, paragraph 50, 67)(disclosing questions from physician to patient regarding past diagnosis and treatment, said questions being a form of inquiry).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

As per claim 18, Goldenberg discloses a method further comprising the step of interfacing with a client computer system to upload demographic information, (Goldenberg, paragraph 50)(disclosing transmitting and gathering a patient history screen to adequately answer an inquiry, said patient history screen is considered to include demographic information).

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The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

**5. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg, (U.S. Pub. 2002/0065682), in view of Joao, (U.S. 2002/0032099), and further in view of Stephanou, (U.S. 6,505,166).**

As per claim 19, Goldenberg fails to disclose a method further comprising the step of recruiting at least one physician to participate in said network of physicians. However, such a method step is well-known in the art as evidenced by Stephanou, (Stephanou, col. 7, lines 51-57).

It would be obvious to one of ordinary skill in the art to combine Goldenberg and Joao with Stephanou. The motivation would be to create a virtual help desk to provide experts in many areas of expertise immediately and competently in response to queries for help from customers. However, such a method step is well-known in the art as evidenced by Stephanou, (Stephanou, col. 2, lines 30-33).

As per claim 20, Goldenberg fails to disclose a method further comprising the step of further comprising the step of providing independent review of the referral prior to the step of generating said request. However, such a method step is well-known in the art as evidenced by Stephanou, (Stephanou, col. 3, lines 26-43)(disclosing a reviewing a database of qualified experts based on availability prior to generating a request for that expert).

The motivation to combine the teachings of Goldenberg, Joao and Stephanou is discussed in the rejection of claim 19 and incorporated herein by reference.

As per claim 21, Goldenberg fails to disclose a method further comprising the step of further comprising the step of tracking the success rates and costs of referrals among the network of physicians. However, such a method step is well-known in the art as evidenced by Stephanou, (Stephanou, col. 4,

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lines 21-51. col. 6, lines 18-23)(disclosing tracking of performance and fees via a survey, said performance and fees are considered to be equivalent to success rates and costs of referrals).

The motivation to combine the teachings of Goldenberg, Joao and Stephanou is discussed in the rejection of claim 19 and incorporated herein by reference.

### ***Response to Arguments***

6. Applicant's arguments filed 3/15/2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filled 3/15/2008.

In regard to claims 13 and 14, the Applicant argues the substitution of the payor from Joao for the patient of Goldenberg does not form the claimed invention. In addition, the Applicant argues the Examiner's proposed motivation is insufficient to support the proposed combination (Goldenberg and Joao). The Examiner respectfully submits the Goldenberg reference teaches a method in which data is transmitted between the user and processor, which can then be encoded to provide secure transmission to a remote user such as a physician (Goldenberg: paragraph [0040]). Goldenberg also teaches a method where a user identification and password are needed to further ensure secure access (Goldenberg: paragraph [0042]). In addition, Goldenberg illustrates inquiry follow up by allowing the user to opt for a higher level of service (i.e. consult with a health care provider after receiving medical information) as disclosed in paragraph [0016], [0033], and [0035] of the Goldenberg reference.

Joao discloses an apparatus and method in which a payer (or payor) consists of health insurance providers which include health maintenance organizations (HMO) and/or any other type of health care provider or payer which reads on PPO, POS plan, TPA, and self-insured employer (Joao: paragraphs [0123] and [0128]).

Since each element (payer versus patient) and the function of the network based health information systems are shown in the prior art, albeit shown as separate references, the difference

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between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the payer of Lipton for the patient of Goldenberg.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

In regard to claim 19, the applicant argues the motivation is completely irrelevant to the inclusion of the steps in the claimed method. In response to the Applicant's arguments, the Examiner respectfully submits the Goldenberg and Joao references, in combination, teach a computer based method of managing a network of physicians. The Goldenberg and Joao references fail to explicitly teach recruiting, review of referrals, and tracking. The addition of the Stephanou reference reads on the recruiting, review of referrals, and tracking limitations as stated in the rejection of claims 19 - 20.

Stephanou teaches an online system which enables a customer (i.e. physician) to participate as a subject matter expert via an expert help network. The expert help network is a system and method for assigning an expert to a request for assistance from a pool of qualified experts (Abstract). It would be obvious to include the invention of Stephanou in the method taught by the combination of Goldenberg and Joao with the motivation of creating a virtual help desk to provide experts in many areas of expertise immediately and competently in response to queries for help from customers (Stephanou, col. 2, lines 30-33). The Examiner interprets a help desk to be a computer based system where users can make inquiries and receive responses based on the inquiries.

Thus, the Applicant's argument is rendered non-persuasive.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626